REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance. The present amendment is being made to facilitate prosecution of the application.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 25-45 and 47 are currently pending. Claims 25 and 40 are independent. Claims 25, 26, 29, 33, 35, 37, 38, 40, and 41 are hereby amended. Claim 46 is canceled herein without prejudice or disclaimer of subject matter. Support for this amendment is provided though out the Specification as filed. No new matter has been added. Changes to claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. 35 U.S.C. §112 REJECTIONS

Claims 25-47 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

Claims 25-47 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite.

The amendments to the claims, without prejudice, render the rejections moot.

III. 35 U.S.C. §103 REJECTIONS

Claims 25-31 and 33-47 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Pompe, et al. (AR) in view of U.S. Patent No. 5,560,960 to Singh, et al. and Richter, et al. (AQ).

Claim 32 was rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Pompe, et al. (AR) in view of Singh, et al. and Richter, et al. (AQ) and further in view of U.S. Patent No. 5,670,680 to Newman, et al.

Independent claim 25, as amended, recites, *inter alia*:

> "...wherein the metal complex-nucleic acid conjugate is formed by the specific reacting of the nucleic acid specific metal complex with bases of the nucleic acid..." (emphasis added)

Applicants submit that the combination of Pompe, Singh, and Richter, taken alone or in combination, does not disclose or suggest the above-identified features of claim 25.

Therefore, independent claim 25 is believed to be patentable.

For reasons similar to or somewhat similar to those described above with regard to independent claim

IV. OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION

Claims 25-47 were provisionally rejected under the judicially-created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-22 and 24-35 of co-pending Application Serial No. 10/210,812 (the " '812 application") in view of Singh et al. Applicants disagree.

A finding of obviousness-type double patenting turns on whether the invention defined in a claim in the application in issue is an obvious variation of the invention defined in a claim of a prior patent. *See, e.g., In re Berg*, 46 U.S.P.Q.2d, 1226 (Fed. Cir. 1998). In order for

an obviousness-type double patenting rejection to stand, the Examiner must show that the claims in this application are obvious **based solely on the claims in the prior patent**; the disclosure in the prior patent can not be used as prior art.

When comparing the claims of the '812 application to the claims of the instant application, Applicants submit that the Examiner's provisional double patenting rejection is improper. For example, there is no teaching in the claims of the '812 application of removing non-conjugated metal complexes and/or non-conjugated by-products. Further, there is no motivation in the claims of the '812 application to combine its teachings with that of Singh in order to obtain the claimed invention. Applicants submit that the requisite suggestion and motivation are absent from the claims of the '812 application and the obviousness-type double patenting rejection must fail as a matter of law.

Consequently, reconsideration and withdrawal of the provisional obviousness-type double patenting rejection are respectfully requested.

V. DEPENDENT CLAIMS

The other claims in this application are each dependent on one of the independent claims discussed above and are therefore believed patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

CONCLUSION

In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference, or references, it is respectfully requested that the Examiner specifically indicate the portion, or portions, of the reference, or references, providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicants respectfully request early passage to issue of the present application.

Respectfully submitted,

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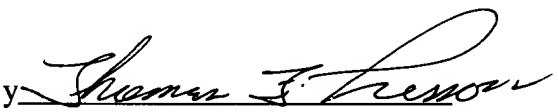
By 
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